

REMARKS

Claims 1-9, 15-17, 19, 20, 22, 24, 25, and 27-29 were pending in the application. Claims 1-9, 15, 24-25, and 27-29 have been canceled as being directed to non-elected inventions. Claims 16, 19, and 22 have been amended and new claims 33-38 have been added. Support for the amendments to the claims and for the new claims can be found in the specification and claims as filed. Specifically, support for the amendments to claims 16, 19 and 22 can be found in the claims as originally filed and, for example, at page 3, lines 5-7 of the specification. Applicants reserve the right to pursue the non-elected claims in this or continuing applications. No new matter has been added.

Objection to the Priority Claim

The Examiner has objected to the priority claim made in the ADS in the declaration. Applicants submit herewith a revised declaration and a revised ADS.

Information Disclosure Statement

The Examiner has objected to the information disclosure statement. Applicants submit herewith a revised information disclosure statement. Applicants respectfully request consideration of the references cited therein.

Objection to the Specification

The Examiner has objected to the Specification because the abstract is not contained on a separate sheet. Attached hereto please find a separate sheet containing the abstract. Please enter this sheet as page 19 of the specification. This sheet contains no new matter.

Claim Objections

The Examiner has objected to claims 16, 17, 19, 20 and 22 because the claims depend from non-elected inventions. Applicants have amended the claims, thereby rendering this rejection moot.

The Examiner has objected to claims 16 and 19 because of the abbreviations DT-A and PEA. Applicants have amended these claims, thereby rendering this rejection moot.

The Examiner has objected to claim 19 because of the a grammatical error. Applicants have amended this claim, thereby rendering this rejection moot.

The Examiner has also objected to claim 19 as improperly depending from a method claim. Applicants have amended this claim, thereby rendering this rejection moot.

Based on the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw the foregoing claim objections.

Rejection of Claims 16, 17, 19, 20 and 22 Under 35 USC 112, First Paragraph

The Examiner has rejected claims 16, 17, 19, 20 and 22 under 35 USC 112, first paragraph. Specifically, the Examiner believes that the specification “while being enabling for a method of killing a cell in vivo using direct delivery of the adenovirus to the cell and a method of killing a cell in vitro, does not reasonably provide enablement for a method of killing a cell in vivo using a genus of administration routes.”

Applicants respectfully traverse this rejection. As the Examiner is aware, the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. In re Angstadt, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976). In the instant application, Applicants claim methods of killing cells both in vivo and in vitro using adenovirus, wherein the adenovirus is produced by a packaging cell line, wherein the cell line is capable of producing adenovirus that expresses the A subunit of diphtheria toxin (DT-A) or Pseudomonas Exotoxin A (PEA), and wherein the cell line does not produce replication-competent adenovirus when used in conjunction with non-overlapping E1-deleted adenovirus.

The Examiner has admitted in the instant office action that the claims are enabled for in vitro and in vivo methods of killing cells when the adenovirus is directly administered to the cell to be killed (see, for example, page 9, first full paragraph).

The Examiner admits that the claimed methods work to kill cells when directly administered. The assertion that administering these same adenovirus particles by other well known methods of administration renders that claims as being non-enabled is not true. Modes of administration disclosed in the instant specification include oral, rectal, nasal, topical, vaginal and parenteral (including subcutaneous, intramuscular, intravenous, and intradermal) are well characterized and well known to one of ordinary skill in the art.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the foregoing rejection.

Rejection of Claims 19 and 20 Under 35 USC 112, Second Paragraph

The Examiner has rejected claims 19 and 20 under 35 USC 112, second paragraph as being indefinite. Specifically, the Examiner is of the opinion that the limitation “the tissue specific promoter or enhancer” lacks the proper antecedent basis. Applicants have amended claims 19, thereby rendering this rejection moot.

Rejection of Claims 16, 17, 19 and 22 Under 35 USC 103

The Examiner has rejected claims 16, 17, 19 and 22 under 35 USC 103(a) as being unpatentable over Rodriguez et al. taken with Kunitomi et al. in view of Wilson et al. Applicants respectfully traverse this rejection.

While in no way acquiescing to the validity of the Examiner’s rejection, and solely in the interest of expediting prosecution, Applicants have amended the claims to specify that the cell line cell line has a mutated EF-2 gene.

The primary reference, Rodriguez et al., does not teach or suggest this feature, and the secondary references, Kunitomi et al. and Wilson et al., do not make up for this deficiency.

Accordingly, the combination of the cited references would not lead one of ordinary skill in the art to the claimed invention.

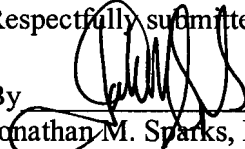
Therefore, Applicants respectfully request that the Examiner reconsider and withdraw the foregoing rejection.

CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Dated: April 24, 2007

Respectfully submitted,

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